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| APPLICATION NO.                                                                                | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|------------------------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/805,337                                                                                     | 03/22/2004  | Norbert Stadele      | STADELE2            | 9096             |
| 1444                                                                                           | 7590        | 09/24/2007           | EXAMINER            |                  |
| BROWDY AND NEIMARK, P.L.L.C.<br>624 NINTH STREET, NW<br>SUITE 300<br>WASHINGTON, DC 20001-5303 |             |                      | MUSSER, BARBARA J   |                  |
|                                                                                                |             | ART UNIT             | PAPER NUMBER        |                  |
|                                                                                                |             | 1733                 |                     |                  |
|                                                                                                |             | MAIL DATE            | DELIVERY MODE       |                  |
|                                                                                                |             | 09/24/2007           | PAPER               |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 10/805,337             | STADELE, NORBERT    |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | Barbara J. Musser      | 1733                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 June 2007.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 9-11 is/are pending in the application.
- 4a) Of the above claim(s) 10 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 9 and 11 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alden(WO 2004/041541A1) in view of Welschlau(US Patent 4,587,898) as evidenced by Spann(US Patent 6,491,361), and further in view of Heaven et al.(U.S. Patent 5,658,432) and Panebianco(WO02/084008A2).

Alden discloses a method of printed corrugated board wherein pre-formed sheets of corrugated board are printed using an ink-jet printer, and cut in accordance with the printed design.(Abstract; Pg. 2, ll. 26-27) The reference does not disclose this process being part of in-line formation the corrugated web. Welschlau discloses forming a corrugated board by printing on a continuous web, joining the web with a corrugated web, and cutting the formed corrugated product.(Figure 1; Col. 6, ll. 4-12) It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the process of Alden inline wherein the corrugated board is formed and then printed and cut since Welschlau discloses forming and cutting a corrugated web in an inline process and since this would allow continuous formation of the product. While Alden does not disclose the printer is a digital printer, Spann is cited to show that an ink

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jet printer is considered a digital dot matrix printer.(Col. 1, ll. 13-15) Thus the ink jet printer of Alden is considered a digital printing process.

The references cited above do not disclose a method to determine the shrinkage of the corrugated board or a method of determining scaling factors. Heaven et al. discloses placing marks on the paper at an upstream location and measuring their spacing at a downstream location to determine the amount of shrinkage and thus the scaling factors.(abstract) Panebianco discloses determining the amount of shrinkage of an article and accounting for it so that the final article is the desired size.(abstract) It would have been obvious to one of ordinary skill in the art at the time the invention was made to determine the final shrinkage of the corrugated board by placing marks on the board and measuring their spacing downstream to determine scaling factors and to determine the image size based on the scaling factors so that the final image is the desired size since Heaven et al. discloses determining the amount of shrinkage using marks, and such shrinkage is known in the paper and corrugated board arts, and since Panebianco discloses using the scaling factors so that the final article is the desired size.(Abstract)

Regarding claim 11, Alden discloses printing after forming the corrugated web.

#### ***Response to Arguments***

3. Applicant's arguments filed 6/22/07 have been fully considered but they are not persuasive.

Regarding applicant's argument that Spann would not be considered when forming corrugated board, the reference is cited as an evidence reference, i.e. a reference to show what something means. It is not used as part of an obvious statement, but is cited as evidence that Alden is a digital dot matrix printer since it shows an ink jet printer is considered a digital printer. This is similar to citing a dictionary since it is a statement of fact that is being used to explain something.

Regarding applicant's argument that the references do not disclose the newly claimed subject matter, Heaven et al. and Panebianco do.

Regarding applicant's argument that Alden is not making corrugated board, Welschlau is. It is well-known in the manufacturing arts to make processes inline as shown by Welschlau.

4. In response to applicant's argument that Alden is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the reference is in applicant's field of endeavor since it is a method of printing on corrugated board.

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara J. Musser whose telephone number is (571) 272-1222. The examiner can normally be reached on Monday-Thursday; alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571)-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
BJM



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